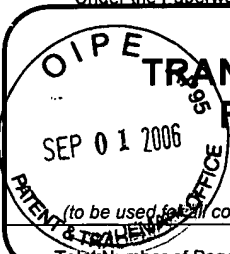
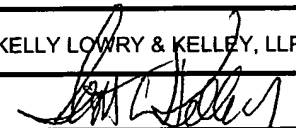


Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

 TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/033,832
	Filing Date	March 3, 1998
	First Named Inventor	Walter W. Mosher, Jr.
	Art Unit	3611
	Examiner Name	Green, B.
Total Number of Pages in This Submission	Attorney Docket Number	PREDYN-42891

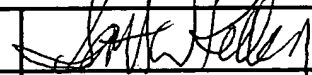
ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached FEE PREVIOUSLY PAID <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Copy of related Appeal No. 2001-1638
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	KELLY LOWRY & KELLEY, LLP		
Signature			
Printed name	Scott W. Kelley		
Date	8/28/2006	Reg. No.	30,762

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature			
Typed or printed name	Scott W. Kelley	Date	8/28/2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Mail Stop, Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. BOX 1450, Alexandria, VA 22313-1450 on August 28, 2006.

By: Scott W. Kelley August 28, 2006
Scott W. Kelley, Reg. No. 30,762 Date

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re Application of

WALTER W. MOSHER, JR.

Serial No. 09/033,832

Filed: March 3, 1998

FOR: IDENTIFICATION DEVICE HAVING
REUSABLE TRANSPONDER

Group Art Unit: 3611

Examiner: Brian Green

Our Docket No. PREDYN-42891

AMENDED APPEAL BRIEF

MS: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant hereby submits its Amended Appeal Brief in response to the Notice of Non-Compliant Appeal Brief mailed August 15, 2006, in connection with the above-identified Application, and further to its Notice of Appeal from the Examiner to the Board of Patent Appeals and Interferences, filed May 30, 2006.

TABLE OF CONTENTS

	<u>Page</u>
I. REAL PARTY IN INTEREST	1
II. RELATED APPEALS AND INTERFERENCES	2
III. STATUS OF CLAIMS	3
IV. STATUS OF AMENDMENTS	4
V. SUMMARY OF CLAIMED SUBJECT MATTER.....	5
VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL.....	9
VII. ARGUMENT	10
VIII. CLAIMS APPENDIX	23
IX. EVIDENCE APPENDIX	28
X. RELATED PROCEEDINGS APPENDIX.....	29

I. Real Party In Interest

The real party in interest of this Appeal is Precision Dynamics Corporation,
having an address of 13880 Del Sur Street, San Fernando, California 91340.

II. Related Appeals and Interferences

This application number 09/033,832 was previously the subject of an appeal to the Board of Patent Appeals and Interferences. Appeal No. 2001-1638 was decided on February 27, 2002.

III. Status of Claims

Claims 30, 32, 35-38, 41, 43 and 44 are currently pending, stand rejected, and are presented for consideration on appeal.

Claims 1-29, 31, 33-34, 39-40 and 42 have been cancelled.

IV. Status of Amendments

Applicant has not filed any amendments subsequent to the final rejection.

V. Summary of Claimed Subject Matter

The present invention is directed to two different embodiments of a radio frequency identification device. According to independent claim 30 the radio frequency identification device comprises an elongated and disposable flexible strap (18) having first and second opposite ends and having a fastening opening (17) in one of said ends.

The strap (18) engages a securement means (14) incorporating a fastening element (16) engageable with said fastening opening (17) to removably connect said strap (18) for supporting and retaining said strap in a closed loop configuration encircling an object or an individual to be identified. The securement means (14) carries a radio frequency identification circuit (30). The strap (18) carries an antenna (33) that is connected to the radio frequency identification circuit (30) by coupling means (32) when said securement means (14) is connected to said strap (18), and disconnected when said securement means (14) is disconnected from said strap (18). The securement means (14) and radio frequency identification circuit (30) are adapted for subsequent assembly and re-use with a replacement strap (18) when removed from the disposable strap (18).

The fastening element comprises a boss (16) located inside the securement means (14) for removable attachment to the fastening opening (17) in the first end of the strap (18). The securement means (14) further defines an opening extending therethrough for slide-through passage of the second end of the strap (18). (FIGS. 1 and 2) (pg. 6, line 3 – pg. 9, line 3)

According to independent claim 38 the radio frequency identification device comprises an elongated and disposable flexible strap (18) having first and second opposite ends and having a fastening opening (17) formed in said first end. The strap

(18) connects to a securement means (14) incorporating a fastening element (16) engageable with said fastening opening (17) to removably connect said strap (18) for supporting and retaining said strap in a closed loop configuration encircling an object or an individual to be identified. The securement means (14) further defines an opening extending therethrough for slide-through passage of the second end of the strap (18). The securement means (14) carries a radio frequency identification circuit (30). The strap (18) carries an antenna (33) that is operatively and removably connected to the radio frequency identification circuit (30) by coupling means (32) when said securement means (14) is connected to said strap (18), and disconnected when said securement means (14) is disconnected from said strap (18). The securement means (14) and radio frequency identification circuit (30) carried thereon are adapted for subsequent assembly and re-use with a replacement strap (18) when removed from the disposable strap (18). The fastening element comprises a boss (16) located inside the securement means (14) for removable attachment to the fastening opening (17) in the first end of the strap (18). (FIGS. 1 and 2) (pg. 6, line 3 – pg. 9, line 3)

According to independent claim 35, the radio frequency identification device comprises an elongated and disposable flexible strap (40) having first and second opposite ends (68) and a pair of fastening openings (46) formed respectively at said first and second ends (68) of said strap (40). A securement means (60) incorporating a fastening element engageable with said fastening openings (46) is removably connectable to said strap (40) for supporting and retaining said strap in a closed loop configuration encircling an object or an individual to be identified. A radio frequency identification circuit (62) is carried by said securement means (60). An antenna (66) is

carried by said strap (40), and a coupling means (64) exists for operatively and removably connecting said antenna (66) with said radio frequency identification circuit (62) when said securement means (60) is connected to said strap (40), and for disconnecting said antenna (66) from said radio frequency identification circuit (62) when said securement means (60) is disconnected from said strap (40). Said securement means (60) with said radio frequency identification circuit (62) carried thereby having said fastening element removable from said fastening opening (46) prior to disposal of said strap (40), and being adapted for subsequent assembly and re-use with a replacement strap (40), and further wherein said securement means (60) defines first and second opposite extremities each having a size and shape for interference fit reception respectively into said openings (46) at said strap (40) first and second ends. (FIGS. 3 and 4) (pg. 9, line 4 – pg. 11, line 2)

According to independent claim 41, the radio frequency identification device comprises an elongated and disposable flexible strap (40) having first and second opposite ends (68) and a pair of fastening openings (46) formed respectively at said first and second ends (68) of said strap (40). A securement means (60) is removably connected to said strap (40) for supporting and retaining said strap (40) in a closed loop configuration encircling an object or an individual to be identified. Said securement means (60) defining first and second opposite extremities each having a size and shape for interference fit reception in the said openings (46) at said strap first and second ends (68). A radio frequency identification circuit (62) is carried by said securement means (60). An antenna (66) is carried by said strap (40), and a means (64) exists for operatively and removably connecting said antenna (66) with said radio

frequency identification circuit (62) when said securement means (60) is connected to said strap (40), and for disconnecting said antenna (66) from said radio frequency identification circuit (62) when said securement means (60) is disconnected from said strap (40). Said securement means (60) with said radio frequency identification circuit (62) carried thereby being removable from said strap (40) prior to disposal of said strap (40), and being adapted for subsequent assembly and re-use with a replacement strap (40). (FIGS. 3 and 4) (pg. 9, line 4 – pg. 11, line 2)

VI. Grounds of Rejection to be Reviewed on Appeal

Whether claims 30, 32, and 38, individually, are unpatentable under 35 USC §103(a) over Petersen (U.S. Patent No. 5,479,797) in view of de Jong (U.S. Patent No. 4,612,719) and Tokunaga (U.S. Patent No. 5,168,281).

Whether claims 35-37, 41, 43 and 44, individually, are unpatentable under 35 USC §103(a) over MacDonald (U.S. Patent No. 5,323,554) in view of de Jong (U.S. Patent No. 4,612,719) and Tokunaga (U.S. Patent No. 5,168,281).

VII. Argument

As indicated above, the following claims stand rejected under the cited statute and patents:

- (i) claims 30, 32, and 38, are rejected under 35 USC §103(a) as being unpatentable over Petersen (U.S. Patent No. 5,479,797) in view of de Jong (U.S. Patent No. 4,612,719) and Tokunaga (U.S. Patent No. 5,168,281); and
- (ii) claims 35-37, 41, 43 and 44, are rejected under 35 USC §103(a) as being unpatentable over MacDonald (U.S. Patent No. 5,323,554) in view of de Jong (U.S. Patent No. 4,612,719) and Tokunaga (U.S. Patent No. 5,168,281).

Applicant respectfully asserts that the cited patent fail to teach all of the claim limitations as required under 35 U.S.C. § 103(a). None of the cited references, alone or in combination, teach the claimed configuration.

The present invention claims as a necessary limitation in claims 30, 35, 38 and 41:

"an antenna carried by said strap, and coupling means for operatively and **removably** connecting said antenna with said radio frequency identification circuit when said securement means is connected to said strap, and for **disconnecting** said antenna from said radio frequency identification circuit when said securement means is disconnected from said strap" (emphasis added)

This claim limitation, which appears in each independent claim, requires that the radio frequency identification circuit be removably connected to the antenna; capable of being disconnected therefrom when the disposable strap is removed from the securement means; and subsequently connected to another antenna when another strap is connected thereto.

Contrary to the statement in the Office Action, Applicant has never admitted, in the specification or otherwise, that de Jong, Tokunaga or any other patent cited in the Office Action constitutes art. That part of the specification referenced in the Office Action reads as follows:

“Unfortunately, available RF circuits are relatively expensive and, since conventional wristbands are disposable after use, such circuits would have to be discarded if they were integral components of the wristband.” (page 3, lines 5-8)

The specification immediately preceding this statement discusses the inclusion of radio frequency circuits and antennas in wristbands to make available a wide spectrum of information compared to bar-codes or the like. The cited paragraph discusses the drawback of including expensive radio frequency circuits in wristbands, which are conventionally disposable, requiring that the relatively expensive radio frequency circuit be disposed of along with the wristband. Stating that the inclusion of radio frequency circuits is known in the art is a far cry from admitting that de Jong and/or Tokunaga are prior art.

1. Rejection of Claims 30, 32 and 38 under 35 U.S.C. §103(a)

According to the Office Action, the Petersen reference shows a disposable attachment means (20) and a reusable securement means (10) wherein the extremities of the attachment means pass through openings in the securement means; a first end mounting on a boss (32) and a second end passing through an opening in the securement means and overlapping the first end. The Office Action correctly points out that Petersen does not disclose attaching a radio frequency identification device to the securement means and attaching an antenna for the radio frequency identification

device to the strap. The Office Action relies upon de Jong to show the inclusion of a detection device (2) within a securing device and uses the reference to state that it would have been obvious to modify Petersen by attaching a radio frequency identification device to the securing means.

However, the combination of Petersen with de Jong fails to show including the antenna for the radio frequency identification device in the strap and removably connecting that antenna to the receiver when the securement means is connected to the strap, and for disconnecting the antenna from the receiver when the securement means is disconnected from the strap. The Office Action relies upon Tokunaga for these teachings stating that Tokunaga shows exactly these limitations.

In contrast, the Tokunaga reference upon which the examining attorney relies teaches the exact opposite of a removable antenna. Tokunaga mentions once that the wristband is removably attached, but never mentions that the antenna is removably attached. In fact, Tokunaga teaches away from an antenna with a removable configuration, specifically stating that:

The exposed end, i.e. the flat portion, of connection terminal 4 and connector 5 are **attached so as to form a single unit by means of a mechanical connection**. Once the mechanical connection between connector 5 and connection terminal 4 has been made, **electrical connection is achieved by caulking or welding**. Alternatively connection terminal 4 and connector 5 may be **connected together through a stainless steel process such as metal injection molding**. FIG. 2 shows a cross section of that part of **wristband 2 that is removably attached to casing 1** in the manner of the present

invention. Antenna plate 3, which is insert-molded into the wristband, is fixed permanently into place in a manner that allows 20 kilograms or more of pulling force to be obtained by the non-linear spot welding of three to six places 4a on lower surface of angled section 4b of connection terminal 4. Antenna plate 3 and connecting terminal 4, thus form a single unit in the assembly and are covered by the synthetic rubber wristband. **However, one end 4c of connection terminal 4 is exposed and that end is fixed to casing 1.** The attachment of wristband 2 to casing 1 is accomplished by wristband attachment screws 14 which make a secure connection and also provide for removal of wristband 2 when necessary. Wristband attachment screws 14 are preferably self-tapping screws. (emphasis added)

(Tokunaga, col. 4, line 66 -col. 5, line 23).

Connector 5 and connection terminal 4 are preferably fixed in place by caulking. Caulking is a mechanically performed **permanent securing process**. In this case, after the axis of connector 5 is set in the aperture of connection terminal 4, plastic deformation is performed on the tip of the axis to make it larger than the diameter of the aperture so that it is **permanently secured**. However, their mechanical strength and electrical properties will last for a long period of time if they are **soldered together**.

The **permanent securing** of connector 5 and connection terminal 4 either by means of caulking or soldering is performed before wristband 2 is removably secured to casing 1 by attachment screws 14. Wristband 2, antenna 3, connection terminal 4, connector 5 and packing 6 are assembled as one unit and then mounted on casing 1." (emphasis added)

(Tokunaga, col. 5, lines 44-60).

Tokunaga teaches permanent affixation of the antenna to the connector in the casing. Nothing in Tokunaga suggests that the antenna is removably connected. Tokunaga never once uses the word removable with reference to the antenna. In fact, Tokunaga only describes the antenna as permanently attached to the connector. The only suggestion that Tokunaga teaches a removable antenna comes from the Office Action and that suggestion could only have come from hindsight reconstruction based upon Applicant's disclosure in the present application.

It is clear that Tokunaga contemplates a removable wristband but not a removable antenna. The fact that Tokunaga discusses a permanent connection between the connection terminal 4 and the connector 5 without mentioning a removable relationship clearly shows that it was not contemplated that the antenna would be removable. Such configuration clearly fails to teach the removable nature of the antenna, as well as, the reusable nature of the radio frequency identification circuit with a different antenna as claimed in the present application.

In addition, Tokunaga teaches an alternate embodiment where the connection terminal 4 and connector 5 are manufactured as a single unit.

FIG. 4 shows another embodiment of the present invention. In contrast to the embodiment of FIG. 1, this embodiment features **connection terminal 4 and connector 5 being manufactured as a single-unit, or integral, connection terminal 24** so that greater thinness and compactness of this component is achieved. In addition to improving long-term electrical reliability, this structure permits reduction in manufacturing and assembly costs since there is a reduction in the number of parts. (emphasis added)
(Tokunaga, col. 5, line 63 – col. 6, line 3).

This alternate embodiment is simply another way of stating that the antenna is permanently attached to the connector. As with the earlier discussions in Tokunaga, there is no mention or suggestion of a removable antenna or reusing the radio frequency identification device with another antenna. Such mention or suggestion could only have come from the disclosure in the present application.

Further, Tokunaga teaches that this permanent connection between the connection terminal and the connector take place in a casing, rather than in a securement means. Tokunaga does not disclose a securement means but implies that there is a securement means (i.e., a buckle) located on the wristband opposite the casing. There is absolutely no mention in Tokunaga of an electrical connection between the antenna and a radio frequency identification device located in a securement means.

Thus, Tokunaga is antithetical to the teachings of the claimed invention and the combination of Tokunaga with Petersen and de Jong constitutes hindsight reconstruction based upon the teachings of the claimed invention.

To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP §2143.03 (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

“When prior art references require selective combination ... to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself ...” Uniroyal Inc. v. Rudkin-Wiley Corp. 5

USPQ 2d 1434, 1438 (Fed. Cir. 1988).

It is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention, and the Examiner must avoid the “insidious effect of a hindsight syndrome wherein only that which the inventor taught is used against the teacher”. W.L. Gore & Assoc. v. Garlock, 721 F.2d 1540, 1552, 1553, 220 USPQ 303, 312, 313 (Fed. Cir. 1988).

The burden is on the Examiner to particularly identify the suggestion, teaching, or motivation in the reference(s) for their combination, and not just naming similarities between the reference(s) and the claimed invention. Ruiz v. A.B. Chance Co., 234 F.3d 654 (Fed. Cir. 2000), 57 USPQ 2d 1161, 1166; In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999), 50 USPQ 2d 1614, 1618. In Ruiz v. A.B. Chance Co., 234 F.3d 654 (Fed. Cir. 2000), it was held that “while the references need not expressly teach that the disclosure contained therein should be combined with another, see Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997), the showing of combinability must be “clear and particular.” In the instant office action, the showing of combinability is far from “clear and particular.”

Applicant respectfully asserts that not only is the combinability of these references not “clear and particular”, there is absolutely no suggestion or motivation to make such a combination, other than hindsight gleaned from the invention itself. Specifically, the connection between the wristband and the casing in Tokunaga is such that would require the connection be made prior to attaching the device to a person. The screws which secure the wristband to the casing are attached from the underside and could not be attached once the device is secured to a person’s wrist. A person

contemplating a connection such as that claimed in the instant invention would not look to Tokunaga. In addition, the third reference in the rejection, Tokunaga, teaches away from the exact limitation for which the Office Action relies upon Tokunaga.

Moreover, none of the references appreciate the problem solved by the present invention, namely, reusing relatively expensive radio frequency identification circuitry with a disposable strap containing a relatively inexpensive antenna. None of the prior art references even suggest the possibility of reusing a connection means having a radio frequency identification device with a disposable strap having an antenna connectable to the radio frequency identification device.

In the rare case where the prior art does not appreciate the existence of the problem solved by the invention; the Applicant's recognition of the problem is, in itself, strong evidence of the non-obviousness of the invention. In re Nomiya et al., 184 USPQ 607, 612-613 (CCPA 1975).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. M.P.E.P. §2143 (citing In re Vaeck, 20 USPQ 2d 1438 (Fed.Cir. 1991).

In addition to failing to show a suggestion or motivation in the prior art to combine the cited references, the Office Action has failed to establish the third basic criteria of a *prima facie* case of obviousness: that the prior art references when combined teach or suggest all of the claim limitations. None of the cited references, including the Tokunaga reference, teach or suggest a disposable wristband including an antenna removably connectable to a radio frequency identification device included in a securement means, the securement means being capable of subsequent use with another disposable wristband having another antenna. Tokunaga teaches a permanent connection between the antenna and the connector, a configuration antithetical to the claimed invention. A person having ordinary skill in the art would not look to Tokunaga when considering the claimed invention since its teachings are opposite to those of the present invention.

2. Rejection of Claims 35-37, 41, 43 and 44 under 35 U.S.C. §103(a)

According to the Office Action, the MacDonald reference shows a disposable tubular band (10 or 14) and a reusable securement means (16). The opposite ends of the strap (10 or 14) have openings for receiving the securement means. The Office Action correctly points out that Mac Donald does not disclose attaching a radio frequency identification device to the securement means and attaching an antenna for the radio frequency identification device to the strap. The Office Action relies upon de Jong to show the inclusion of a detection device (2) within a securing device and uses the reference to state that it would have been obvious to modify MacDonald by attaching a radio frequency identification device to the securing means.

However, the combination of MacDonald with de Jong fails to show including the antenna for the radio frequency identification device in the strap and removably connecting that antenna to the receiver when the securement means is connected to the strap, and for disconnecting the antenna from the receiver when the securement means is disconnected from the strap. The Office Action relies upon Tokunaga for these teachings stating that Tokunaga shows exactly these limitations.

As shown above, the Tokunaga reference upon which the examining attorney relies teaches the exact opposite of a removable antenna. Tokunaga mentions once that the wristband is removably attached, but never mentions that the antenna is removably attached. In fact, Tokunaga teaches away from a removable antenna stating that on multiple occasions that the antenna plate (3), connection terminal (4) and/or connector (5) are connected:

- to form a single unit by means of a mechanical connection
- by an electrical connection achieved by caulking or welding
- through a stainless steel process such as metal injection molding
- fixed permanently into place in a manner that allows 20 kilograms or more of pulling force to be obtained by non-linear spot welding
- antenna plate 3 and connecting terminal 4 thus form a single unit in the assembly
- the exposed end 4c of the connection terminal 4 is fixed to casing 1
- connector 5 and connection terminal 4 are preferably fixed in place by caulking – a permanent securing process
- after the axis of connector 5 is set in the aperture of connection terminal 4, plastic deformation is performed on the tip so that it is permanently secured
- soldering is suggested for a more durable connection

- permanent securing of connector 5 and connection terminal 4 by caulking or soldering

Tokunaga teaches permanent affixation of the antenna to the connector in the casing. Nothing in Tokunaga suggests that the antenna is removably connected. Tokunaga never once uses the word removable with reference to the antenna. In fact, Tokunaga only describes the antenna as permanently attached to the connector. The only suggestion that Tokunaga teaches a removable antenna comes from the Office Action and that suggestion could only have come from hindsight reconstruction based upon Applicant's disclosure in the present application.

It is clear that Tokunaga contemplates a removable wristband but not a removable antenna. The fact that Tokunaga discusses a permanent connection between the connection terminal 4 and the connector 5 without mentioning a removable relationship clearly shows that it was not contemplated that the antenna would be removable. Such configuration clearly fails to teach the removable nature of the antenna, as well as, the reusable nature of the radio frequency identification circuit with a different antenna as claimed in the present application.

In addition, Tokunaga teaches an alternate embodiment where the connection terminal 4 and connector 5 are manufactured as a single unit.

FIG. 4 shows another embodiment of the present invention. In contrast to the embodiment of FIG. 1, this embodiment features **connection terminal 4 and connector 5 being manufactured as a single-unit, or integral, connection terminal 24** so that greater thinness and compactness of this component is achieved. In addition to improving long-term electrical reliability, this structure

permits reduction in manufacturing and assembly costs since there is a reduction in the number of parts. (emphasis added) (Tokunaga, col. 5, line 63 – col. 6, line 3). This alternate embodiment is simply another way of stating that the antenna is permanently attached to the connector. As with the earlier discussions in Tokunaga, there is no mention or suggestion of a removable antenna or reusing the radio frequency identification device with another antenna. Such mention or suggestion could only have come from the disclosure in the present application.

Further, Tokunaga teaches that this permanent connection between the antenna and the connector take place in a casing, rather than in a securement means. Tokunaga does not disclose a securement means but implies that there is a securement means (i.e., a buckle) located on the wristband opposite the casing. There is absolutely no mention in Tokunaga of an electrical connection between the antenna and a radio frequency identification device located in a securement means.

Thus, Tokunaga is antithetical to the teachings of the claimed invention and the combination of Tokunaga with MacDonald and de Jong constitutes hindsight reconstruction based upon the teachings of the claimed invention.

Applicant respectfully asserts that not only is the combinability of these references not “clear and particular”, see, In Ruiz v. A.B. Chance Co., 234 F.3d 654 (Fed. Cir. 2000), there is absolutely no suggestion or motivation to make such a combination, other than hindsight gleaned from the application itself. Specifically, the connection between the wristband and the casing in Tokunaga is such that would require the connection be made prior to attaching the device to a person. The screws which secure the wristband to the casing are attached from the underside and could not

be attached once the device is secured to a person's wrist. A person contemplating a connection such as that claimed in the instant invention would not look to Tokunaga. In addition, the third reference in the rejection, Tokunaga, teaches away from the exact limitation for which the Office Action relies upon Tokunaga.

Moreover, none of the references appreciate the problem solved by the present invention, namely, reusing relatively expensive radio frequency identification circuitry with a disposable strap containing a relatively inexpensive antenna. None of the prior art references even suggest the possibility of reusing a connection means having a radio frequency identification device with a disposable strap having an antenna connectable to the radio frequency identification device. See, In re Nomiya et al., 184 USPQ 607, 612-613 (CCPA 1975).

In addition to failing to show a suggestion or motivation in the prior art to combine the cited references, the Office Action has failed to establish the third basic criteria of a *prima facie* case of obviousness: that the prior art references when combined teach or suggest all of the claim limitations. None of the cited references, including the Tokunaga reference, teach or suggest a disposable wristband including an antenna removably connectable to a radio frequency identification device included in a securement means, the securement means being capable of subsequent use with another disposable wristband having another antenna. Tokunaga teaches a permanent connection between the antenna and the connector, a configuration antithetical to the claimed invention. A person having ordinary skill in the art would not look to Tokunaga when considering the claimed invention since its teachings are opposite to those of the present invention.

VIII. Claims Appendix

1-29. Canceled.

30. (previously presented) A radio frequency identification device, comprising:
an elongated and disposable flexible strap having first and second opposite ends
and having a fastening opening in one of said ends;

securement means incorporating a fastening element engageable with said
fastening opening to removably connect said strap for supporting and retaining said
strap in a closed loop configuration encircling an object or an individual to be identified;

a radio frequency identification circuit carried by said securement means; and
an antenna carried by said strap, and coupling means for operatively and
removably connecting said antenna with said radio frequency identification circuit when
said securement means is connected to said strap, and for disconnecting said antenna
from said radio frequency identification circuit when said securement means is
disconnected from said strap;

said securement means with said radio frequency identification circuit carried
thereby having said fastening element removable from said fastening opening prior to
disposal of said strap, and being adapted for subsequent assembly and re-use with a
replacement strap;

said fastening element comprising a boss located internally of said securement
means, said strap first end having said fastening opening formed therein for removably
attaching said strap first end to said boss, and said securement means further defining
an opening extending therethrough for slide-through passage of said strap second end.

31. Canceled.

32. (previously presented) The radio frequency identification device of claim 30 wherein said radio frequency identification circuit is embedded within said securement means.

33. Canceled.

34. Canceled.

35. (previously presented) A radio frequency identification device, comprising:
an elongated and disposable flexible strap having first and second opposite ends and having a pair of fastening openings formed respectively at said first and second ends of said strap;

securement means incorporating a fastening element engageable with said fastening opening to removably connect said strap for supporting and retaining said strap in a closed loop configuration encircling an object or an individual to be identified;

a radio frequency identification circuit carried by said securement means; and

an antenna carried by said strap, and coupling means for operatively and removably connecting said antenna with said radio frequency identification circuit when said securement means is connected to said strap, and for disconnecting said antenna from said radio frequency identification circuit when said securement means is disconnected from said strap;

wherein said securement means with said radio frequency identification circuit carried thereby having said fastening element removable from said fastening opening prior to disposal of said strap, and being adapted for subsequent assembly and re-use with a replacement strap, and further wherein said securement means defines first and second opposite extremities each having a size and shape for interference fit reception respectively into said openings at said strap first and second ends.

36. (previously presented) The radio frequency identification device of claim 35 wherein said antenna is carried by said strap generally at said first end thereof for operative connection with said radio frequency identification circuit when said first extremity of said securement means is received into the opening at said strap first end.

37. (previously presented) The radio frequency identification device of claim 35 wherein said strap comprises an elongated tubular band.

38. (previously presented) A radio frequency identification device, comprising:
an elongated and disposable flexible strap having first and second opposite ends, said strap first end having a fastening opening formed therein;
securement means incorporating a fastening element engageable with said fastening opening to removably connect said strap for supporting and retaining said strap in a closed loop configuration encircling an object or an individual to be identified;
said securement means further defining an opening extending therethrough for slide-through passage of said strap second end;

a radio frequency identification circuit carried by said securement means; and
an antenna carried by said strap, and coupling means for operatively and
removably connecting said antenna with said radio frequency identification circuit when
said securement means is connected to said strap, and for disconnecting said antenna
from said radio frequency identification circuit when said securement means is
disconnected from said strap;

said securement means with said radio frequency identification circuit carried
thereby having said fastening element removable from said fastening opening prior to
disposal of said strap, and being adapted for subsequent assembly and re-use with a
replacement strap.

39. Canceled.

40. Canceled.

41. (previously presented) A radio frequency identification device, comprising:
an elongated and disposable flexible strap having first and second opposite
ends, said strap defining a pair of fastening openings formed respectively at said first
and second ends thereof;

securement means removably connected to said strap for supporting and
retaining said strap in a closed loop configuration encircling an object or an individual to
be identified, said securement means defining first and second opposite extremities
each having a size and shape for interference fit reception respectively into said

openings at said strap first and second ends;

a radio frequency identification circuit carried by said securement means; and

an antenna carried by said strap, and means for operatively and removably connecting said antenna with said radio frequency identification circuit when said securement means is connected to said strap, and for disconnecting said antenna from said radio frequency identification circuit when said securement means is disconnected from said strap;

said securement means with said radio frequency identification circuit carried thereby being removable from said strap prior to disposal of said strap, and being adapted for subsequent assembly and re-use with a replacement strap.

42. Canceled.

43. (previously presented) The radio frequency identification device of claim 41 wherein said antenna is carried by said strap generally at said first end thereof for operative connection with said radio frequency identification circuit when said first extremity of said securement means is received into the opening at said strap first end.

44. (previously presented) The radio frequency identification device of claim 41 wherein said strap comprises an elongated tubular band.

IX. Evidence Appendix

None

X. Related Proceedings Appendix

Appeal No. 2001-1638, BPAI, February 27, 2002.

Respectfully submitted,

KELLY LOWRY & KELLEY, LLP

By: 

Scott W. Kelley
Reg. No. 30,762
Attorney for Applicant

SWK:cw

6320 Canoga Avenue
Suite 1650
Woodland Hills, CA 91367
(818) 347-7900

266/127

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18



UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte WALTER W. MOSHER JR., MICHAEL L. BEIGEL and THOMAS P. MAHONEY

Appeal No. 2001-1638
Application No. 09/033,832

ON BRIEF

Before COHEN, FRANKFORT, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 19 to 25 and 27, which are all of the claims pending in this application.

We AFFIRM.

RECEIVED
MAR 14 2002
IRVING OFFICE

BACKGROUND

The appellants' invention relates to RF (radio frequency) identification devices designed to permit the transmission of information about a person or thing to whom or which the RF identification devices are secured (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

de Jong	4,612,719	Sep. 23, 1986
Hayes	4,718,374	Jan. 12, 1988
Pennock et al. (Pennock)	5,140,946	Aug. 25, 1992

Claim 20 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

Claim 25 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Hayes.

Claims 19 to 25 and 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over de Jong in view of Hayes.

Claims 19 to 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Pennock in view of Hayes.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 14, mailed July 26, 2000) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 13, filed July 13, 2000) and reply brief (Paper No. 15, filed September 22, 2000) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness rejection

We sustain the rejection of claim 20 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id. If the scope of the invention sought to be patented cannot be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is appropriate.

The failure to provide explicit antecedent basis for terms does not always render a claim indefinite. As stated above, if the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. See Ex parte Porter, 25 USPQ2d 1144, 1146 (Bd. Pat. App. & Int. 1992).

In this rejection under 35 U.S.C. § 112, second paragraph, the examiner determined (answer, p. 3) that claim 20 was indefinite because there was no antecedent basis for "said circuit means." The appellants argue (brief, p. 6; reply brief, pp. 2-3) that the rejection is not well founded since the claimed "said circuit means" of

claim 20 is referring back to the "radio frequency identification circuit" recited in parent claim 19.

In our view, the scope of claim 20 would not be reasonably ascertainable by those skilled in the art. Thus, claim 20 is indefinite. In that regard, one skilled in the art would not be reasonably able to ascertain if the reference to "said circuit means" in claim 20 is (1) referring back to the "radio frequency identification circuit" recited in parent claim 19,¹ (2) adding a reference to a "circuit means" other than the "radio frequency identification circuit" recited in parent claim 19, or (3) changing the "radio frequency identification circuit" recited in parent claim 19 to be a means clause (i.e., radio frequency identification circuit means).² In view of this uncertainty, the metes and bounds of claim 20 has not been set forth with a reasonable degree of precision and particularity.

For the reasons set forth above, the decision of the examiner to reject claim 20 under 35 U.S.C. § 112, second paragraph, is affirmed.

¹ If this was the case the appellants could have easily amended claim 20 to overcome this rejection by amending "said circuit means" in claim 20 to read "said circuit" or more precisely "said radio frequency identification circuit."

² The scope of "radio frequency identification circuit" may be different from the scope of "radio frequency identification circuit means."

The anticipation rejection

We sustain the rejection of claim 25 under 35 U.S.C. § 102(b) as being anticipated by Hayes.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

Claim 25 reads as follows:

Reusable securement means having a body with securement portions thereupon, said securement portions being demountably engagable with opposite extremities of disposable attachment means to maintain said attachment means on an object or individual, said body having radio frequency identification circuit means embedded therein.

Hayes' invention relates to animal ear tags, and more particularly, to a multiple purpose ear tag assembly comprising a main tag member and a tag attachment member and which may include an insecticide member and attachment means, and an electronic identification signal generating means. In general, the two piece ear tag assembly 20 comprises an identification member 22 made of one piece of resilient molded plastic material and an attachment member 24 made of one piece of relatively rigid, but also resilient molded plastic material, which assembly is adapted to be mounted on the ear 26 of a bovine type animal as shown in Figures 1-3.

The identification member 22 comprises a flat relatively thin enlarged identification portion 40 having a generally polygonal peripheral configuration, a first reduced tapered width vertically extending intermediate connecting portion 42, a second further reduced tapered width rearwardly inclined intermediate portion 44, a narrow width vertically downwardly extending strap portion 45 and an enlarged connecting head portion 46 which is connectably associated with attachment member 24. The identification portion 40 is adapted to bear suitable visual identifying indicia 47 applied to a forwardly facing front marking surface 48. Strap portion 45 has parallel side edge surfaces 53, 54 and extends downwardly through a vertical slit 70 in the animal ear area 36, and through a central vertical passage 55 (see Figure 5) in attachment member 24. Head portion 46 has upwardly facing abutment surface means

56, 57 engaging downwardly facing lower surface abutment means on flexible rib portions 58, 59 of attachment member 24. A conventional active or passive electronic signal sending means 60 may be suitably mounted on or attached to the identification member 22. In one embodiment, means 60 is mounted on upwardly rearwardly inclined connecting portion 44 for sending a coded electronic identification signal to an electronic signal receiving means 62.

Figures 4 and 5 of Hayes show an attachment tag member 64 attached to identification member 22 by suitable attachment means 66. The insecticide tag attachment means 66 comprises an elongated slot defined by a flat bottom surface 100 and a pair of inclined side surfaces 102, 104 on flexible lip portions 106, 108 integrally molded in portion 42. Insecticide tag means 64 comprises a rectangular block-shape piece of conventional extrusion molded resilient flexible plastic and includes an integrally molded elongated rib portion 116 having a flat outer side surface 117 and inclined side surfaces 118, 119 which correspond to slot surfaces 100, 102, 104 so as to enable rib portion 116 to be inserted in and removed from the slot.

Hayes teaches (column 5, lines 36 et seq.) that

[i]n one presently proposed embodiment of the invention, the identification signal generating means 60 on the ear tag is a conventional electronic chip device with conventional miniaturized electronic circuitry and an antenna which is capable of receiving activating electromagnetic energy and responding thereto

by emitting a coded radio frequency digital signal. The identification signal receiving means is a conventional device which generates electromagnetic energy for actuating the identification signal generating means and which is capable of receiving, decoding, transmitting an analog signal. Both the identification signal generating means and the identification signal receiving and transmitting means may be of the same general design as apparatus currently manufactured and sold by B. I. Corporation of Boulder, Colo., and described in U.S. Pat. No. 4,475,481, the disclosure of which is incorporated herein by reference; but may also be other designs including the type wherein the signal generating means is battery operated and does not depend on receipt of activating energy from the signal receiving means. The identification signal receiving means 62 activates the ear tag signal generating means 60 by transmitting an electromagnetic field burst of fixed duration. The signal generating means 60 acquires energy from the field and responds by transmitting back to the generating means a radio frequency digital coded message signal which contains the unique number programmed into the electronic chip device. The generating means receives the coded signal and conditions it into a data signal that can be sent to electronic data processing means.

The animal identification signal transmitting means 60 may be encased in plastic, is of relatively small size, e.g., approximately 15 to 25 mm X 15 to 25 mm X 3 to 5 mm, or less, and of relatively low weight, e.g., 5 to 10 grams. The range of transmission of both the transmitting means and the receiving means is preferably limited to approximately between six inches to 3 feet, and the data storage capacity is approximately at least twenty to thirty binary digits (bits) of data plus other digits for preamble and parity (error detection) so that the system allows for up to 1,000,000 or more different unique codes which may be programmed into the electronic chip during manufacture.

In our view, claim 25 is met by Hayes. Claim 25 is readable on Hayes as follows:

Reusable securement means (Hayes' identification member 22 is clearly a securement means since it is secured to an animal's ear and is capable of being reused if and when attachment member 24 breaks or needs to be replaced) having a body with securement

portions thereupon (Hayes' identification member 22 comprises portions 40-46 including connecting head portion 46 to secure attachment member 24 thereto and portion 42 with insecticide tag attachment means 66 to attach insecticide tag means 64 thereto), said securement portions being demountably engagable with opposite extremities of disposable attachment means to maintain said attachment means on an object or individual (Hayes' connecting head portion 46 and insecticide tag attachment means 66 are capable of being demountably engagable with opposite extremities of a suitable disposable attachment means to maintain the attachment means on an object or individual), said body having radio frequency identification circuit means embedded therein (Hayes' identification member 22 has a identification signal generating means 60 that receives and transmits a radio frequency).

The argument presented by the appellants in the briefs does not convince us that the subject matter of claim 25 is novel. Specifically, we disagree with the appellants' argument that Hayes' identification member 22 is not reusable. In that regard, while Hayes does not specifically teach that his identification member 22 is reusable, it is readily apparent to us that since the identification member 22 is made of resilient molded plastic material, it inherently possesses the capability of being reused such as when the attachment member 24 breaks or needs to be replaced. Likewise, while Hayes does not specifically teach that his identification member 22 is

demountably engagable with opposite extremities of a disposable attachment means to maintain the attachment means on an object or individual, it is immediately evident to us that Hayes' identification member 22 inherently possesses the capability of being demountably engagable with opposite extremities of a suitable disposable attachment means to maintain the attachment means on an object or individual.

Thus, the appellants' arguments concerning how the claimed securement means is used are unpersuasive. It should be remembered that claim 25 is directed to a reusable securement means, per se, not to a method wherein this particular securement means is used. It is well settled that the manner or method in which a machine is to be utilized is not germane to the issue of patentability of the machine itself. See In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967); In re Yanush, 477 F.2d, 958, 959, 177 USPQ 705, 706 (CCPA 1973). Furthermore, it is our opinion that Hayes' identification member 22 would be fully capable of the uses recited in claim 25. Thus, it is our opinion that claim 25 is readable on Hayes.

For the reasons set forth above, the decision of the examiner to reject claim 25 under 35 U.S.C. § 102(b) is affirmed.

The obviousness rejection based on de Jong and Hayes

We sustain the rejection of claims 19 to 25 and 27 under 35 U.S.C. § 103 as being unpatentable over de Jong in view of Hayes.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Claims 19 and 21 read as follows:³

19. A radio frequency device comprising:
disposable attachment means for locating said device on an object or an individual to be identified, said attachment means being a disposable wristband, said wristband having opposite extremities;
reusable securement means demountably engagable with the opposite extremities of said wristband to maintain said wristband in temporary operative relationship with and being separable from said extremities when said wristband is discarded; and
radio frequency identification circuit embedded in said securement means for reuse with said securement means with a replacement wristband after the disposable wristband has been discarded.
21. A radio frequency identification device comprising:
disposable attachment means having opposite extremities;

³ Claim 25, the only other independent claim on appeal, has been reproduced earlier in this decision.

securement means separably connected to said opposite extremities of said attachment means for maintaining said attachment means in temporary-operative relationship with an object or individual to be identified; and radio frequency identification circuit means embedded in said securement means and being removable with said securement means from said attachment means for subsequent use with replacement attachment means.

de Jong's invention concerns a holder for an electronic detection element adapted to be attached by means of a band around the neck or around a different part of the body of an animal to be detected. Figure 1 shows a first embodiment of the holder wherein a detection element 2 diagrammatically shown is embedded. At the bottom of the holder there is pivotally provided a flap 3 at one end at 4, which flap serves for clamping one of the ends of a band 6. Figure 3 shows a second embodiment of the holder wherein the responder 2 is embedded in the cavity of the flap 3 and consequently is integral with the flap, but, as shown, this embodiment may also be provided with retaining lugs 11, which are adapted to detachably retain through snap action a loose responder block. Figure 8 shows another embodiment in which a wedge 80 is fitted at the bottom with teeth to clamp respective ends of the band 6. In this embodiment, the responder block 2 is detachably retained in the appropriate cavity in the holder by retaining lugs 81, which are comparable with the retaining lugs 11 of Figure 3. Finally, Figure 9 shows a variant in which the band ends are each provided between and about three ribs 90, 91 and 92 integral with the holder and designed as shear pins.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

The examiner ascertained (answer, p. 4) that the embodiments of Figures 8 and 9 of de Jong do not disclose that the responder includes a radio frequency identification circuit or that the responder is embedded in the securement means. With regard to these differences, the examiner then determined (answer, p. 4) that (1) "[i]n view of the teachings of Hayes it would have been obvious [at the time the invention was made] to one [of ordinary skill] in the art to modify de Jong by including a radio frequency identification circuit means within the responder since this would allow information from the responder to be sent out and received in an easier manner," and (2) "[i]n view of the teachings of figure 1 of de Jong it would have been obvious [at the time the invention was made] to one [of ordinary skill] in the art to modify figures 8 and 9 of de Jong by embedding the responder within the securement means since this would allow the responder to be attached to the securement means in a more secure manner.

The argument advanced by the appellants in the briefs does not convince us of any error in the above-noted determinations made by the examiner. In that regard, the appellants' argument that no piece of prior art teaches a securement means with an

embedded RFID (radio frequency identification) circuit removably associated with a disposable attachment means is not germane to this rejection since this rejection is under 35 U.S.C. § 103, not 35 U.S.C. § 102. In this case, it is our opinion that the combined teachings of de Jong and Hayes would have made the subject matter of claims 19, 21 and 25 obvious at the time the invention was made to a person of ordinary skill in the art for the reasons set forth above.

For the reasons set forth above, the decision of the examiner to reject claims 19, 21 and 25 under 35 U.S.C. § 103 as being unpatentable over de Jong in view of Hayes is affirmed.

Dependent claims 20, 22 to 24 and 27 have not been separately argued by the appellants. Accordingly, we have determined that these claims must be treated as falling with their respective independent claim. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987) and 37 CFR §§ 1.192(c)(7) and 1.192(c)(8)(iv). Thus, it follows that the decision of the examiner to reject claims 20, 22 to 24 and 27 under 35 U.S.C. § 103 as being unpatentable over de Jong in view of Hayes is also affirmed.

The obviousness rejection based on Pennock and Hayes

We will not sustain the rejection of claims 19 to 25 under 35 U.S.C. § 103 as being unpatentable over Pennock in view of Hayes.

Pennock's invention relates generally to illuminated pet collars, and more particularly to a pet collar which includes a removable transparent tube into which a plurality of lights are operably connected for viewing.

The appellants argue that the applied prior art does not suggest the claimed subject matter. We agree.

In our view, the only suggestion for modifying Pennock's pet collar to include a radio frequency identification circuit as taught by Hayes stems from hindsight knowledge derived from the appellants' own disclosure.⁴ The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course,

⁴ Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellants. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In this case, we see no motivation, suggestion or teaching in the applied prior art of Pennock and Hayes of the desirability of modifying Pennock to arrive at the claimed subject matter.

impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claims 19 to 25 under 35 U.S.C. § 103 as being unpatentable over Pennock in view of Hayes is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claim 20 under 35 U.S.C. § 112, second paragraph, is affirmed; the decision of the examiner to reject claim 25 under 35 U.S.C. § 102(b) is affirmed; the decision of the examiner to reject claims 19 to 25 and 27 under 35 U.S.C. § 103 as being unpatentable over de Jong in view of Hayes is affirmed; and the decision of the examiner to reject claims 19 to 25 under 35 U.S.C. § 103 as being unpatentable over Pennock in view of Hayes is reversed.

Since at least one rejection of each of the appealed claims has been affirmed, the decision of the examiner is affirmed.

AFFIRMED

BOARD OF PATENT
APPEALS
AND
INTERFERENCES

Appeal No. 2001-1638
Application No. 09/033,832

Page 19

THOMAS P. MAHONEY LAW OFFICES
5 COLLINS ISLE
BALBOA ISLAND, CA 92662

JVN/jg